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Intellectual Property Causes
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IFW

Attorney Docket No. P24008**Mail Stop Amendment**

In re application of : Peter HILFENHAUS et al.

Application No : 10/654,949

Group Art Unit: 1771

Filed : September 5, 2003

Examiner : Matzek, Matthew D.

For : ANTIMICROBIAL COMPOSITE

Mail Stop Amendment

Commissioner for Patents

U.S. Patent and Trademark Office

Customer Service Window, Mail Stop Amendment

Randolph Building

401 Dulany Street

Alexandria, VA 22314

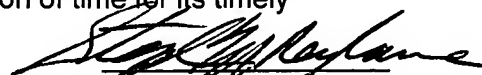
Sir:

Transmitted herewith is an **Election with Traverse** in the above-captioned application.☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.☐ An Information Disclosure Statement, PTO Form 1449, and references cited.☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 104	*104	0	X25=	\$	x 50=	\$0.00
Indep. Claims: 5	**5	0	X100=	\$	X200=	\$0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$0.00
Extension Fees for ____ Month(s)				\$		\$0.00
Total:				\$	Total:	\$0.00

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$ ____.☐ N/A A Check in the amount of \$ ____ to cover the filing/extension fee(s) is included.☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.☒ Any additional filing fees required under 37 C.F.R. 1.16.☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).


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P24008.A06



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Peter HILFENHAUS et al.

Confirmation No. 7944

Group Art Unit: 1771

Serial No. :10/654,949

Examiner: Matzek, Matthew D.

Filed : September 5, 2003

For : ANTIMICROBIAL COMPOSITE

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
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401 Dulany Street
Alexandria, VA 22314

Sir:

This is in response to the requirement for restriction under 35 U.S.C. § 121 mailed from the U.S. Patent and Trademark Office on May 16, 2005. Inasmuch as the one-month shortened statutory period is originally set in the Office Action to expire on June 16, 2005, this response is being filed by the initial due date for response and no extension of time is believed to be necessary. However, if any extension of time is deemed necessary, this is an express request for any necessary extension of time and authorization to charge any necessary extension of time fee or any other fees which may be required to preserve the pendency of the present application to Deposit Account No. 19-0089.

RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following inventions:

- I. Claims 1-81, drawn to an antimicrobial composite, classified in class 442, subclass 1.
- II. Claims 82-94, drawn to a method of using an antimicrobial composite, classified in class 442, subclass 1.
- III. Claims 95-104, drawn to a process of making an antimicrobial composite, classified in class 156, various subclasses.

Further, the Examiner also requests that if invention I is elected, a second election be made, i.e.,

Specie A: Claims 1-73, 78 and 80-81

Specie B: Claims 74-77 and 79.

Applicants note that the Examiner has indicated that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim.

Still further, the Examiner requests that if groups comprising claims 35, 90 or 99 are

elected, Applicants must select one antimicrobial metal for the purpose of examination.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect, with traverse the invention set forth in **claims 1-81** (invention I as identified in the Restriction Requirement), **Specie A** (i.e., claims 1-73, 78 and 80-81). At least claims 1-73, 78 and 80-81 read on Specie A. Further, for examination purposes **silver (Ag)** is selected as antimicrobial metal.

TRAVERSE

Applicants respectfully submit that a restriction requirement is inappropriate in this case. Even if one were to assume, *arguendo*, that the inventions of Groups I to III are distinct, the requirement for restriction should be withdrawn, because there is no serious burden.

In MPEP Chapter 800, the Office sets forth its policy by which examiners are guided in requiring restriction under 35 U.S.C. § 121. Section 803 states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants note that all of the three inventions identified in the Restriction Requirement relate to antimicrobial composites, specifically, an antimicrobial composite, the use of the antimicrobial composite to cover a wound, and a process of making the antimicrobial composite. Accordingly, as a practical matter, the searches for inventions I

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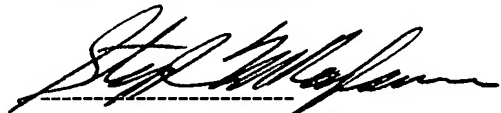
to III should significantly overlap. For example, a search for invention I should cover many areas that are also relevant for inventions II and III. Thus, the search burden would not be serious. Incidentally, the Restriction Requirement does not allege that there would be a serious search burden if all three inventions I and III had to be searched, let alone explain why a serious search burden allegedly exists.

For the above reasons alone, the Restriction Requirement should be withdrawn, which action is respectfully requested.

The Examiner is reminded of the rejoinder practice set forth in MPEP § 821.04, i.e., if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend or otherwise include all of the limitations of the allowable product claim will be rejoined.

Should there be any questions, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,
Peter HILFENHAUS et al.



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June 15, 2005
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